

### **REMARKS**

With this amendment, claims 1, 5, 22, 23, 33, 35, 36, 42, 49 and 77 have been amended. New claims 79-83 have been added. Claim 4 has been cancelled. Applicants respectfully request reconsideration of the present Office Action based on the remarks set forth below.

#### **Interview Summary**

Applicants thank Examiner Mehta (newly assigned to this matter) for participating in a telephonic interview on July 18, 2007. During the interview, attorney for Applicants and the Examiner discussed the teachings of the McCrory publication and Klein patent in light of the pending claims. The Examiner also identified several additional prior art references, which Applicants submit in the enclosed Supplemental IDS for the Examiner's consideration.

#### **Claim Amendments**

Independent claims 1, 33, 35, 42, 49 and 77 have been amended to clarify that the solid material is detectable by and compatible with at least two imaging modalities. This amendment does not alter the scope of the claims, but rather, clarifies the scope of the claims as originally filed in light of the cited prior art. Claims 1, 33, 35 and 42 have also been amended to recite that the marker is distinguishable from of the anatomical site when imaged. These amendments are supported by claims 49 and 77 as well as page 13, lines 9-15 of the specification as originally filed. Claims 1, 33, 35 and 42 have also been amended to clarify that the solid material is detectable by and compatible with at least one magnetic field imaging modality and at least one non-magnetic field imaging modality. These amendments are supported by, for example, claim 4 as originally filed. Certain dependent claims were amended in light of the amendments to the independent claims.

New claims 79 and 80 recite embodiments described in the specification and claims as originally filed. Both claims require the marker to be formed from (claim 79) or consist essentially of (claim 80) a solid substrate. New claims 81-83 describe tissue markers formed

from a ceramic material such as zirconium oxidw. These claim features are described in the specification at, for example, page 11, lines 25-30.

#### Objections to Drawings

The Office Action objected to the drawings under 37 C.F.R. § 1.83(a) for purportedly failing to show every feature of the claimed invention. Pursuant to 37 C.F.R. § 1.81, drawings are only required “where necessary for the understanding of the subject matter sought to be patented.” The Office Action did not provide any basis as to why the claims as currently pending require amended drawings. Applicants respectfully request that Examiner either withdraw or clarify this objection.

#### Claim Rejections

Claim 1-32 and 42-78 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,394,965 to Klein (“Klein”) in view of U.S. published application 2001/0004395 to McCrory et al. (McCrory). Claims 33-41 were not listed in the rejected claims, however, Applicants have treated these claims as being rejected on the same basis.

The Examiner asserted that Klein teaches implanting a detectable tissue marker at a tissue sight, but does not teach that the marker is multi-modal. The Examiner asserted that McCrory teaches a permanent multi-modal marker, and that it would have been obvious to use the marker described in McCrory as a tissue marker according to the method described by Klein. Applicants respectfully request that the Examiner withdraw this rejection because, even if combined, these references do not teach or suggest each feature of the independent claims.

Klein describes methods for permanently marking tissue sites such as biopsy and polyp removal sites by injecting a plurality of biocompatible detectable microparticles into soft tissue at or near the tissue site. McCrory, in contrast, describes a discreet fiducial marker that includes a liquid-filled cylindrical container configured to be embedded in bony tissue. Pars. [0029]-[0033]. The liquid enclosed in the container may include an “aqueous imaging agent to provide imaging capability under MRI.” Par. [0015].

Each pending independent claim recites a permanent implantable marker including a *solid material* that is detectable by and compatible with at least one magnetic field imaging modality (e.g., MRI) and at least one non-magnetic field imaging modality (e.g., X-ray, ultrasound). Each claim also recites that the marker is distinguishable from anatomical sites in images formed from such imaging modalities.

McCrory does not teach or suggest a marker including a *solid material* that is detectable under a magnetic field imaging modality and a non-magnetic field imaging modality. Instead, McCrory teaches the use of one or more *liquid* contrast agents to render the fiducial marker detectable under, for example, MRI and CT. Accordingly, even if it would have been obvious to combine McCrory and Klein as asserted by the Office Action, this combination does not teach or suggest each feature of the independent claims. Applicants respectfully request withdrawal of this rejection.

New claims 79-83 are allowable at least for the reasons asserted above.

### **CONCLUSION**

All of the claims remaining in this application are in condition for allowance. If there are any remaining questions, the Examiner is encouraged to contact the undersigned at the number listed below.

Respectfully submitted,

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Dated: August 13, 2007  
fb.us.1610740.01